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**TRANSMITTAL
FORM**

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Total Number of Pages in This Submission

12

Application Number	09/787,339
Filing Date	03/16/2001
First Named Inventor	Arnoldus Werner Johannes Oomen
Art Unit	2655
Examiner Name	Gautam Patel
Attorney Docket Number	PHN 17,547

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Remarks Enclosed is a Petition to rescind a restriction requirement.		

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Technology Center 2600

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	James D. Leimbach Reg. No. 34,374
Signature	
Date	March 23, 2004

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Date	March 23, 2004

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 130.00)

Complete if Known

Application Number 09/787,339

Filing Date 03/16/2001

First Named Inventor Arnoldus W. J. Oomen

Examiner Name Gautam Patel

Art Unit 2655

Attorney Docket No. PHN 17,547

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METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Order Other None
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The Director is authorized to: (check all that apply)

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Fee Code (\$)	Fee	Small Entity	Fee Code (\$)	Fee	Fee Description	Fee Paid
1001	770	2001	385			Utility filing fee	<input type="text"/>
1002	340	2002	170			Design filing fee	<input type="text"/>
1003	530	2003	265			Plant filing fee	<input type="text"/>
1004	770	2004	385			Reissue filing fee	<input type="text"/>
1005	160	2005	80			Provisional filing fee	<input type="text"/>
SUBTOTAL (1) (\$)							

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>	=	<input type="text"/>	Extra Claims	Fee from below	Fee Paid
Independent Claims	<input type="text"/>	- 3** =	<input type="text"/>	X	<input type="text"/>	=	<input type="text"/>			
Multiple Dependent	<input type="text"/>		<input type="text"/>	X	<input type="text"/>	=	<input type="text"/>			

Large Entity	Fee Code (\$)	Fee	Small Entity	Fee Code (\$)	Fee	Fee Description				
1202	18	2202	9			Claims in excess of 20				
1201	86	2201	43			Independent claims in excess of 3				
1203	290	2203	145			Multiple dependent claim, if not paid				
1204	86	2204	43			** Reissue Independent claims over original patent				
1205	18	2205	9			** Reissue claims in excess of 20 and over original patent				
SUBTOTAL (2) (\$)										

**or number previously paid, if greater; For Reissues, see above

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee (\$)	Fee Code (\$)	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	<input type="text"/>
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	<input type="text"/>
1053	130	1053	130	Non-English specification	<input type="text"/>
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	<input type="text"/>
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	<input type="text"/>
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	<input type="text"/>
1251	110	2251	55	Extension for reply within first month	<input type="text"/>
1252	420	2252	210	Extension for reply within second month	<input type="text"/>
1253	950	2253	475	Extension for reply within third month	<input type="text"/>
1254	1,480	2254	740	Extension for reply within fourth month	<input type="text"/>
1255	2,010	2255	1,005	Extension for reply within fifth month	<input type="text"/>
1401	330	2401	165	Notice of Appeal	<input type="text"/>
1402	330	2402	165	Filing a brief in support of an appeal	<input type="text"/>
1403	290	2403	145	Request for oral hearing	<input type="text"/>
1451	1,510	1451	1,510	Petition to institute a public use proceeding	<input type="text"/>
1452	110	2452	55	Petition to revive - unavoidable	<input type="text"/>
1453	1,330	2453	665	Petition to revive - unintentional	<input type="text"/>
1501	1,330	2501	665	Utility issue fee (or reissue)	<input type="text"/>
1502	480	2502	240	Design issue fee	<input type="text"/>
1503	640	2503	320	Plant issue fee	<input type="text"/>
1460	130	1460	130	Petitions to the Commissioner	<input type="text"/>
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	<input type="text"/>
1806	180	1806	180	Submission of Information Disclosure Stmt	<input type="text"/>
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	<input type="text"/>
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	<input type="text"/>
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	<input type="text"/>
1801	770	2801	385	Request for Continued Examination (RCE)	<input type="text"/>
1802	900	1802	900	Request for expedited examination of a design application	<input type="text"/>

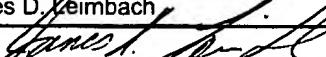
Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 130.00)

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)	James D. Heimbach	Registration No. (Attorney/Agent)	34,374	Telephone	(585)3819983
Signature				Date	March 23, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Arnoldus W. J. Oomen *et al.*

Serial No. 09/787,339

Filed: 03/16/2001

TITLE: RECORD CARRIER CARRYING A
STEREO SIGNAL AND A DATA SIGNAL

) Atty. Docket PHN 17,547

)

)

) Group Art Unit:
2655

) Examiner:
Gautam Patel

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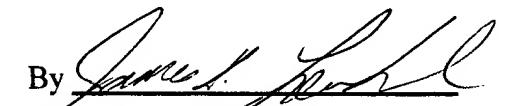
MAR 29 2004

Technology Center 2600

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This communication contains a Petition under 37 C.F.R. §1.144 from a requirement for restriction that was made in the Final Office Action mailed December 23, 2003.

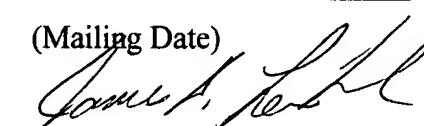
By 
James D. Leimbach, Reg. No. 34,374
Patent Attorney (585) 381-9983

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Commissioner for Patents
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Alexandria VA. 22313-1450

on: March 23, 2004

(Mailing Date)


(Signature)

03/26/2004 CCHAU1 00000059 09787339

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130.00 0P

Petition From Requirement For Restriction Under 37 C.F.R. §1.144

Petition is, hereby, made to the Honorable Commissioner for Patents from a requirement for restriction made in the December 23, 2003 Final Office Action for United States Application Serial No. 09/787,339. The December 23, 2003 Final Office Action withdrew all claims to United States Application Serial No. 09/787,339 from consideration as being directed to a non-elected invention. The Examiner has taken the position that the claims presented by the Petitioner in the November 11, 2003 amendment are independent or distinct from the invention as originally claimed. In the February 3, 2004 response to the Final Office Action, the Petitioner filed a request for reconsideration of the requirement for restriction. The Examiner upon reconsideration refused to rescind the requirement for restriction, as noted in the February 11, 2004 Advisory Action.

The December 23, 2003 Final Office Action stated that the claims submitted by the Petitioner on November 11, 2003 were independent or distinct from the invention originally claimed. The amendment to the claims made on November 11, 2003 by the Petitioner that resulted in the restriction requirement was a change that replaced the term "channel" with the term "physical feature". The Examiner stated on page 2 of the Final Office Action (paper 10) that the original claims "were directed to an invention of a record carrier recording stereo signals and data signals in a channel comprising first portion and second portion" and that the new amended claims and new claims filed on November 11, 2003 by the Petitioner are directed towards a "stereo signal being recorded USING first physical feature and second physical feature which are different from each other". The Petitioner would like to respectfully point out that the first channel is defined by the specification of the invention on page 3, beginning on line 29 as being "formed by optically detectable marks in a track, whereby the optically detectable marks are in the form of so-called pits". The Petitioner would further like to point out that the term second channel is defined by the specification to the present invention on page 3, line 1 as the "second channel is preferably written by variations of the track." The term "physical feature" is not given any special definition by the specification to the present invention. Accordingly, the term "physical feature" should be interpreted as commonly used. The Petitioner respectfully submits that optically detectable marks in the form of

pits (the first channel) and variations of the track (the second channel) are physical features. The November 11, 2003 amendment to the claims replaced the term "channel" with the term "physical feature" to more particularly point out and distinctly claim the invention in an attempt to prevent a broad reading of the invention from being on the cited prior art references.

The analysis below discusses Claim 1 and Claim 8 to the invention. The Petitioner respectfully points out that the discussion below relating to Claims 1 and 8 is illustrative of the issues that exist to all the claims of the invention which have been subjected to the restriction requirement contained within the December 23, 2003 Final Office Action.

The Petitioner would like to draw attention to the recitations the amendment made to Claim 1 of the invention by the November 11, 2003 amendment, which is reproduced below.

Claim 1 (currently amended): A record carrier carrying a stereo signal and a data signal, said stereo signal being recorded using in a first physical feature on said record carrier channel, characterized in that the data signal comprises a first portion and a remaining portion, said first portion being combined with said stereo signal to obtain a composite signal being recorded in using said first physical feature channel on said record carrier and the remaining portion being recorded in using a second physical feature channel on said record carrier different from said first physical feature.

The Petitioner respectfully submits that the term "first channel" as defined by the specification of the invention as being formed by optically detectable marks in a track, whereby the optically detectable marks are in the form of so-called pits is wholly consistent with the term "first physical feature" provided by the November 11, 2003 amendment. The Petitioner further submits that the term "second channel" as defined by the specification of the invention is preferably written by variations of the track is wholly consistent with the term "second physical feature" provided by the November 11, 2003 amendment. The term "physical feature" was used by the Petitioner to replace the term

“channel” to more particularly point out and distinctly claim the invention. The term “channel” is simply a broader term than the term “physical feature”. The replacement of the term “channel” with the term “physical feature” does not result in claim terminology that is independent or distinct from the invention as originally claimed.

The Petitioner would like to draw attention to the recitations made by Claim 8 before the November 11, 2003 amendment that resulted in the restriction requirement that is the subject of this petition. Claim 8 before the November 11, 2003 amendment is reproduced below.

Claim 8 (original). The record carrier as claimed in any of the preceding claims characterized in that said first channel is represented by first variations of a first physical parameter of the record carrier and said second channel is represented by second variations of a second physical parameter of the record carrier, said second physical parameter differing from said first physical parameter.

Before the November 11, 2003 amendment, Claim 8 specifically recited that the “first channel is represented by first variations of a first physical parameter of the record carrier” and that the “second channel is represented by second variations of a second physical parameter of the record carrier differing from said first physical parameter.” The Petitioner respectfully submits that the definitions of variations in physical parameters applied to the first and second channels in Claim 8 before the November 11, 2003 amendment is essentially equivalent to reciting variations within first and second physical features.

Claim 8 depends from Claim 1 and incorporates the elements of Claim 1. As previously discussed, the definition supplied by the specification to the invention for the term first channel in Claim 1 is “pits” and the definition supplied by the specification of invention for the term second channel in Claim 1 is “variations in the track”. The logical interpretation of Claim 8 prior the November 11, 2003 amendment is that the first channel comprises pits represented by first variations of a first physical parameter and that the second channel comprises variations in the track represented by second variations

of a second physical parameter of the record carrier differing from the first physical parameter.

The first channel was always defined by the specification as being optically detectable marks in a track, whereby the optically detectable marks are in the form of so-called pits. This is a definition consistent with the term "physical feature". The second channel was always defined by the specification as being variations in the track, which also is a term consistent with the term "physical feature". The claims as originally submitted defined the term channel as being a variation in a physical parameter of the record carrier, which is consistent with the term physical feature. Accordingly, the Petitioner respectfully submits that it is not proper for the Examiner to have interpreted the term "channel" in such a manner that would exclude the term "physical feature".

The first office action dated May 7, 2003 (paper 3) subjected Claims 1-26 of the invention to a restriction requirement. The restriction requirement contained in paper 3 stated that there were three distinct species, each being an optical storage device: the first embodiment as shown in Figures 1 and 2; the second embodiment as shown in Figures 3 and 4; and the third embodiment as shown in Figures 5 and 6. There was no classification mention in paper 3. In paper 6 a non-final office action on the merits was sent to the Petitioner after the election, there is no mention of classification of the invention.

The Examiner stated on page 2 of the December 23, 2003 Final Office Action that the claims prior the November 11, 2003 amendment were directed to a record carrier recording stereo signals and data signals in a channel comprising first portion and second portion classified within class 381/10, 381/23 and/or 369/59.27. The Petitioner would like to respectfully point out that this is a misstatement by the Examiner. The claims prior the November 11, 2003 amendment were directed to a record carrier recording wherein the first portion was recorded in a first channel and the remaining portion was recorded in a second channel. The proper interpretation is that the first portion is recorded in pits and the remaining portion was recorded in variations in the track because this is the definition given by the specification as previously discussed. The Examiner also stated in the December 23, 2003 Final Office Action that the claims filed by the November 11, 2003 amendment are directed to a stereo signal being recorded using a first physical feature and a second physical feature which are different from each other which falls within class 369/275.3. The first channel is formed of pits, which is a physical

feature in the record carrier, and the second channel is formed of variations in the track of the record carrier, which is also a physical feature.

As discussed above, the Petitioner was not made aware of the specific classification of the invention. However, the restriction requirement contained in paper 3 stated that there were three distinct species, each being an optical storage device. The Petitioner selected the embodiment that included definitions of the channels as being variations within a physical parameter. The specification defines the first channel as being pits and the second channel as being variations in the track. The elements within the elected claims should always have been viewed as reciting being recording signals via physical features of the record carrier. It may very well be the case that the Examiner incorrectly classified the invention elected by the Petitioner and this is not the fault of the Petitioner. The Petitioner was not informed of the classification made by the Examiner in paper 3 that subjected Claims 1-26 of the invention to the original restriction requirement. Paper 6 is the non-final office action on the merits sent to the Petitioner after the election of the first embodiment made no mention of the classification that the examiner was intending. The Petitioner elected claims directed towards recording signal in a record carrier via variations of physical parameters in channels, which channels are defined as pits and variations in the track. Variations in pits and tracks of a record carrier are variations in physical features of the record carrier.

As previously discussed, Claim 8 prior the November 11, 2003 amendment, the first and second channels were defined as variations of physical parameters within the record carrier. The Petitioner submits that if the terminology from Claim 8 of variations of physical parameters within the record carrier had been incorporated by the November 11, 2003 amendment into Claim 1 that no restriction would have resulted. The Petitioner respectfully submits that a variation of a physical parameter is essentially equivalent to a variation within physical feature of the record carrier. At the very least, using the terminology "physical features within the record carrier" compared to the original claims that recited "variations of physical parameters within the record carrier" does not result in claims that are independent or distinct.

There should be no question that if the November 11, 2003 amendment had attempted to change the first and second channel to, respectively, first variations of a first physical parameter and second variations of a second physical parameter that no restriction would have resulted because this terminology already existed in Claim 8 and the change would

be nothing more than incorporating the limitations of a dependent claim in to the base claim. There should also be no question that if the November 11, 2003 amendment had attempted to change the first and second channel to first and second physical parameters that no restriction would have resulted, again because again these are simply limitations that were within a dependant claim.

The November 11, 2003 amendment replaced the terms "first channel" with "first physical feature" and the term "second channel" with the term "second physical feature". The Applicants, respectfully, submit that replacing the term channel with the term physical feature does not create an independent or distinct invention, especially wherein channel is defined by Claim 8 as originally submitted as a variation of a physical parameter, and wherein the specification defines the first channel as pits and the second channel as variation in the track.

The MPEP at §803 details when restriction is proper and when restriction is not proper. The MPEP at §803 clearly states that if "the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The Petitioner avers that the claims provided by the November 11, 2003 amendment are not independent or distinct from the invention originally claimed. The Petitioner respectfully submits that examination of the claims provided by the November 11, 2003 amendment can be made without a serious burden on the part of the Examiner. As previously discussed, Claim 8 as originally filed amendment defined "channel" as variations of physical parameters within a record carrier. Also as previously discussed, the terminology "variations of physical parameters within a record carrier" is essentially equivalent to the terminology "physical features within a record carrier". The examination of the claims as submitted by the November 11, 2003 amendment that recite "physical features" in place of channel no not impose a serious burden on the Examiner.

The Petitioner respectfully points out that any search of the claims filed by the November 11, 2003 amendment should not cause a serious burden on the Examiner. The Examiner states that the claims filed by the November 11, 2003 amendment fall within class 369/275.3. The Examiner has already made a search of class 369/275 and this is evident by citation of Balston et al. (U.S. Patent No. 4,672,600) in the Notice of References Cited provided by the Examiner in relation to the claims originally submitted. Accordingly, it appears that class 369/275 has already been searched. The reclassification suggested by the Examiner has already

been searched, or at least any search required by the November 11, 2003 amendment would not impose a serious burden upon the Examiner.

The Examiner states in the December 23, 2003 Final Office Action, that the November 11, 2003 amendment modified the claims such that they are directed towards a stereo signal being recorded using first physical features and second physical feature which are different from each other and classified in class 369/275.3. The Examiner also states that the original claims were directed towards a record carrier recording stereo signals and data signals in a channel comprising a first portion and a second portion. The Petitioner respectfully submits that the changes made by November 11, 2003 amendment to the claims essentially modified the claims in a manner wholly consistent with the invention originally recited by Claim 8. The Petitioner respectfully points out that Claim 8 as originally submitted defined "channel" as represented by variations of a physical parameter of the record carrier, and that the term "channel" should reasonably have been interpreted as a physical feature. The MPEP at §806(C) states that where "inventions are related as disclosed but are not distinct as claimed, restriction is never proper." The Petitioner respectfully submits that the only reasonable interpretation of the term "channel" is akin to that recited by Claim 8 prior the November 11, 2003 amendment and defined by the specification of the present application for invention.

The MPEP at §806.03 states that where "the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition." As previously discussed, Claim 8 before the November 11, 2003 amendment defined the same essential characteristics as the Claims filed by the November 11, 2003 amendment. The only difference being that the claims filed by the November 11, 2003 amendment are not as broad as those originally filed. Accordingly restriction is not proper.

The Petitioner made the November 11, 2003 amendment to distinguish the claims of the invention from cited references. It appeared that the Examiner was interpreting the term "channel" very broadly. Accordingly, the November 11, 2003 amendment was made to use terminology similar to that used in Claim 8. Claim 8 had no rejection based on the prior art. The Petitioner respectfully asserts that none of claims filed by the November 11, 2003 amendment are independent or distinct from the

invention as originally claimed. Accordingly, the Petitioner requests the Honorable Commissioner for Patents intervene and rescind the restriction requirement to the claims of the invention that was made in the December 23, 2003 Final Office.

Respectfully submitted,

By James D. Leimbach

James D. Leimbach, Reg. 34,374

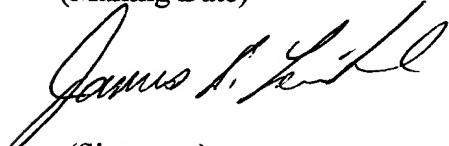
Patent Attorney (585) 381-9983

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on: March 23, 2004

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